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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HUSNU M. KALKANOGLU and
ROBERT L. JENKINS

Appeal 2009-012095
Application 10/807,018
Technology Center 1700

Decided: April 29, 2010

Before EDWARD C. KIMLIN, TERRY J. OWENS, and
PETER F. KRATZ, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-11, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The Appellants claim a method for making a shingle. Claim 3 is illustrative:

3. A method of making a shingle having a butt portion and a tab portion with tabs of desired shading in the tab portion being spaced apart by slots, and with adjacent tabs being sharply defined, comprising the steps of:

(a) providing a base web of reinforcing material impregnated with and coated with an adhesive material as a hardenable coating, to an upper surface and a lower surface thereof;

(b) conveying the impregnated reinforcing material in a longitudinal direction;

(c) applying granules of a first aesthetic onto the hardenable coating on the upper surface in first primary areas, each of a first width, in the tab portion of the continuous strip of shingle material, to cover said first primary areas;

(d) applying granules of a second aesthetic onto the hardenable coating of the upper surface in second primary areas, each of a second width, in the tab portion of the continuous strip of shingle material, to cover said second primary areas; and

(e) applying granules of a mixture of those applied to adjacent primary areas, onto the hardenable coating in intermediate areas between said adjacent primary areas, each intermediate area being of a given width; and

(f) completely removing said given width of intermediate areas.

The Reference

Koschitzky

5,664,385

Sep. 9, 1997

The Rejections

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-7 and 11 over Koschitzky, and claims 8-10 over Koschitzky in view of the Appellants' admitted prior art.

OPINION

We affirm the rejections.

Issue

Have the Appellants shown reversible error in the Examiner's determination that the applied prior art would have rendered prima facie obvious, to one of ordinary skill in the art, completely removing intermediate areas between first and second primary areas on which granules having, respectively, first and second aesthetics are applied to a hardenable coating on a base web of a shingle?

Findings of Fact

Koschitzky discloses "roofing shingles in which the color of the surfacing layer changes at demarcation lines" (col. 1, ll. 6-8). Slots (76) which normally are between about ¼ and ½ inch wide but may be as wide as 2 inches provide sharp demarcation at transition areas (36) between adjacent colored areas (col. 5, ll. 4-6; col. 7, ll. 3-8). The slots (76) "preferably remove the part of the transition area where the two blends are approximately equal" (col. 5, ll. 17-19) such that the remaining portions of the transition areas will not be noticed by the eye (col. 5, ll. 34-37). "[E]ven if each slot 76 does not cover the entire width of the transition area between adjacent colored areas, it will still form (particularly from a distance) a sharp visual demarcation between adjacent colored areas" (col. 7, ll. 16-20).

The Appellants' admitted prior art relied upon by the Examiner (Ans. 5) is that it was known in the art to make laminated shingles comprising two or more layers of complete shingle material (Spec. 1).

Analysis

The Appellants argue that Koschitzky removes only a portion of the transition area whereas the Appellants remove the entire transition area (Br. 6-9; Reply Br. 3-4).

"A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). In making an obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 550 U.S. at 418.

Koschitzky's disclosure that each slot (76) provides a sharp visual demarcation between adjacent colored areas, particularly from a distance, even if the slot (76) does not cover the entire width of the transition area (col. 7, ll. 15-20), would have led one of ordinary skill in the art, through no more than ordinary creativity, to cut slots (76) such that they remove the entire width of each transition area to assure a sharp visual demarcation between adjacent colored areas regardless of whether the viewing is from a distance.

The Appellants argue, in reliance upon the Declarations under 37 C.F.R. § 1.132 of Richard A. Snyder and Robert L. Jenkins, that the Appellants' claimed invention has been a commercial success (Br. 15-17).

Snyder states that the shingles made by the claimed method, although sold for less than 4 years, already have a level of sales in the millions of dollars, which is unusual, and have a year-to-date number of squares sold

which is over 80% of that of another shingle that has been on the market for 15 years (Decl. ¶ 20).¹

Evidence of commercial success must show that there is a nexus between the sales and the technical merits of the claimed invention, i.e., that the sales resulted from the recited characteristics of the claimed invention rather than from another factor such as features of the product not related to the claimed subject matter, low price, marketing and salesmanship, customer service, or a prior business relationship between the company and its customers. *See In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996); *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1151 (Fed. Cir. 1983).

Jenkins states that “[t]he factors of promotion, advertising and marketing that took place for the shingle of this invention from prior to its commercial release and thereafter were essentially the same as those factors for the comparison commercially successful shingle of CertainTeed to which the shingle of this invention is compared in paragraph 20 of the Snyder Declaration” (Decl. ¶ 5).

The Appellants’ evidence of commercial success is not persuasive for the following reasons. First, the Appellants have not shown a nexus between the sales and the technical merits of the claimed method, i.e., the complete removal of the intermediate areas. Second, the sales volume set forth by Snyder of the shingle made by the claimed method does not establish that the sales resulted in increased market share. *See Huang* 100

¹ Snyder does not explain why it is unusual for a sales volume of one laminated shingle that has been on the market for less than 4 years to be over 80% of the sales volume of another laminated shingle that has been on the market for 15 years.

F.3d at 140 (Evidence of the number of units sold “provides no indication of whether this represents a substantial quantity of this market. . . . [E]vidence related solely to the number of units sold provides a very weak showing of commercial success, if any”). Third, Snyder’s number-of-squares-sold comparison between the shingle made by the claimed method and the comparison shingle does not establish that the number of squares sold of the shingle made by the claimed method did not rise to over 80% of that of the comparison shingle due to lower price. Jenkins’ Declaration states that the promotion, advertising and marketing of the shingle made by the claimed method and the comparison shingle were the same, but does not state that the prices were the same. Fourth, evidence of commercial success must be commensurate in scope with the claims, *see In re Tiffin*, 448 F.2d 791, 792 (CCPA 1971), and the Appellants’ evidence, which is limited to a laminated shingle, is not commensurate in scope with claims 1-7 and 11 which do not require that the method produces a laminated shingle.

Regarding claim 8, which requires applying a second layer to make a laminated shingle, the Appellants argue that lamination enhances the aesthetic effect (Br. 18), but the Appellants do not explain why forming Koschitzky’s shingle as a laminate would have been unobvious to one of ordinary skill in the art.

With respect to claims 9 and 10, which depend from claim 8 and require that the second layer is applied after (claim 9) or before (claim 10) the intermediate areas are removed, the Appellants argue that those sequences are not in the art of record (Br. 18-19).

It would have been apparent to one of ordinary skill in the art that when a second layer is applied to Koschitzky’s shingle to form a laminate,

the second layer must be applied either before or after the transition areas are removed. The Appellants have not provided a substantive argument as to why either sequence would have been unobvious to one of ordinary skill in the art.

Conclusion of Law

The Appellants have not shown reversible error in the Examiner's determination that the applied prior art would have rendered prima facie obvious, to one of ordinary skill in the art, completely removing intermediate areas between first and second primary areas on which granules having, respectively, first and second aesthetics are applied to a hardenable coating on a base web of a shingle.

DECISION/ORDER

The rejections under 35 U.S.C. § 103 of claims 1-7 and 11 over Koschitzky, and claims 8-10 over Koschitzky in view of the Appellants' admitted prior art are affirmed.

It is ordered that the Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

PL Initial:
sld

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